IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Group Art Unit: 3621
Examiner: Calvin L. Hewitt II

Application of :	Walter D. BUIST
Serial No. :	10/666,817
Filing Date :	September 17, 2003
Entitled :	SYSTEM AND METHOD FOR MESSAGE COMMUNICATION

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

Appellant respectfully submits this Reply Brief in response to the Examiner's

Answer, dated December 27, 2007. For the reasons set forth below and in Appellant's

Amended Brief on Appeal, Appellant respectfully requests that the final rejection of

Claims 1-24 in the Final Office Action, dated May 19, 2006, be reversed.

**I.   The Examiner's Answer Contains New Grounds For Rejection To Which
         Appellant Previously Had Not Been Given A Fair Opportunity To Respond.**

The Examiner's Answer was submitted by Examiner Hewitt, who was not one of

the examiners who examined this application before Appellant appealed. Examiner

Hewitt's Answer advances new positions on claim construction that improperly ignore limitations in the pending claims.

Specifically, Examiner's Answer has argued for the *first* time that a limitation in Claim 1 be read out of the claim and ignored. Specifically, Claim 1 recites "interpreting said message according to a coded meaning defined to be different than the standard, publicly-known meaning within the field delimited communication protocol." It is this limitation that the Examiner now argues should be read out of Claim 1 and be ignored. (Examiner's Answer at 7-9.) The Examiner's Answer has also argued for the *first* time that the limitations of Claims 7, 13, and 22-24 that require messages recited in those claims to be encoded or coded to have a meaning different than the standard, publicly-known meaning under the field delimited protocol used to communicate them should also be read out of those claims and be ignored. (*Id.*)

Examiner Backer, the examiner who handled this application before Examiner Hewitt submitted the Examiner's Answer, did not previously raise these new grounds for rejection. The basic thrust of Examiner Backer's rejection, from which Appellants appealed, was that U.S. Patent Application Publication No. US 2004/0030632 (Hausman) discloses all the limitations of the claims, including those limitations that the Examiner's Answer is now arguing should be read out of the claims. (*See, e.g.*, Amended Appeal Brief at 12-16.)

The Examiner's Answer makes that same incorrect argument, but has devoted only one paragraph to it, and now relies on different portions of the disclosure of

Hausman. (Examiner's Answer at 8-9.)[1] As a result, Appellant has not had a fair

opportunity to respond to the basic thrust of the rejection as newly presented in the

Examiner's Answer. *See, e.g., Application of Kronig*, 539 F.2d 1300, 1302-1303

(C.C.P.A. 1976).

Appellant nevertheless respectfully requests that the appeal be maintained and

therefore addresses this new argument herein. 37 C.F.R. § 41.39(b). As we explain in

greater detail in the next section of this Brief, the Examiner's Answer's new argument

that claim limitations should be ignored is plainly incorrect, both on the facts and on the

law.

II.   The Interpreting, Coding, And Encoding Limitations Cannot Be Ignored And Read Out Of The Pending Claims.

It is black-letter law that "[a]ll words in a claim must be considered in judging the

patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165

USPQ 494, 496 (CCPA 1970); *see also, e.g., Key Manufacturing Group, Inc. v.

Microdot, Inc.*, 925 F.2d 1444, 1448 (Fed. Cir. 1991) (district court erred in ignoring

limitations of claim that distinguished the claim from the prior art).

Here, the Examiner's Answer argues that limitations in Claims 1, 7, 13, 22-24

should be ignored and read out of the claims because the step of interpreting a message

according to a coded meaning is purportedly performed by a human, and patentability

---

[1]   As we explain in Section III below, the Examiner's argument that Hausman fails
to disclose the elements of Claims 1, 7, 13, 22-24 identified in Appellant's Appeal Brief
should be rejected out of hand.

cannot be predicated on a "mental step." (Examiner's Answer at 7-8 (citing *In re Venner*, 120 U.S.P.Q. 192 (C.C.P.A. 1958)).)

First, *Venner* is completely inapposite. In *Venner*, the appellants argued that a timing device for timing the period between the completion of pouring metal into a mold and solidification of the metal in the mold established patentability. *Id.* at 195. However, the timer did not compute the molding period, and the claims did not recite how to compute the molding period. Because other references disclosed the advantages of using timing devices to time the molding period and disclosed the means for automatically removing the mold upon completion of the molding period, the claims were found to be obvious over that combination of prior art. *Id.* In reaching that conclusion, the Court of Customs and Patent Appeals reasoned that a "mental process" was invoked to set the timer and patentability could not be predicated on that "mental step." *Id.*

The *Venner* court did not disregard any of the limitations of the claims at issue. It simply concluded that what was claimed, which did not include how to determine the molding period, was obvious in light of what was disclosed in the prior art. *Venner* by no means authorized ignoring claim limitations as part of an anticipation analysis. The argument in the Examiner's Answer that the "interpreting" step should be read out of Claim 1 (and all of the other claims) should be rejected.

The Examiner's Answer ignores that Claim 22 recites "an interpreter for interpreting the message to have a meaning different from the standard, publicly-known meaning under the field delimited communication protocol." Claim 22 makes crystal

clear that the interpreter of the claimed apparatus is performing what the Examiner's

Answer describes as the "interpretation step." There is no "mental step" performed by a

human in Claim 22.

The Examiner's Answer also ignores that Claims 7, 13, and 23-24 do not recite

(and do not need to recite) the interpreting step recited in Claim 1. Claims 7, 13, and 23-

24 recite methods and apparatus for securely communicating financial information where

messages are encoded to have meanings different than the standard, publicly-known

meaning under the field delimited protocol under which they were communicated.

And the specification and claims make clear that the encoding and coding is

performed using computer interfaces. (*See, e.g.*, Claim 23, reciting "an encoder for

encoding a message in a field delimited communication protocol . . . wherein said

encoded message is intended to have a meaning different from the standard, publicly-

known meaning . . . .")

As explained in the specification and shown in Figure 1, buyer 110 and seller 112

use typical order management interfaces 102A and 102B of firms 100A and 100B.

(Specification ¶ 22.) Order management system interface 102 is preferably a personal

computer, remote terminal, workstation, or other computing entry device adapted to

interact with a firm order management system 100. (*Id.*)

Paragraph 0028 of the Specification describes how buyer 110, seller 112, or a

third party preferably defines how entries in specified fields of the field delimited

protocol will be interpreted. Paragraphs 0030-0036 contain examples of how entries of

the fields of the field delimited protocol can be coded to have meanings outside standard, publicly-known meanings within the field delimited protocol. The encoded messages are entered into the order management interfaces 102A and 102B of computing devices and are received, registered, and matched at the secure repository 104. (Specification ¶ 37.) The encoding is plainly not predicated on any "mental step."

Claim 1 does not require the interpretation step to be performed by a computer. But that is not a reason for rejecting Claim 1. *See, e.g., Application of Musgrave*, 431 F.2d 882, 892 (1970) ("We know of no decision that holds that a method is *per se* unpatentable simply because its practice requires that the operator thereof must think."). Indeed, claims are not unpatentable simply because they some or all of the steps in the claim can also be carried out by a person or because it may be necessary for a person to do some of the steps. *See, e.g., Alco Standard Corp. v. Tennessee Valley Auth.*, 808 F.2d 1490, 1496 ("The inclusion in a patent of a process that may be performed by a person, but that is also capable of being performed by a machine, is not fatal to patentability.") (citing *Diamond v. Diehr*, 450 U.S. 175 (1981)).

In any event, the specification does disclose embodiments where a computing device is used to perform the interpreting step of Claim 1. Claim 1 could readily be amended to specifically claim that the interpreting step is performed using a computing device or telephonic connection as described in the specification. However, since this argument was made for the first time in the Examiner's Answer, such an amendment has not been made.

Figure 1 depicts a secure repository 104. (Specification ¶ 23.) Secure repository

104 is a computing device adapted to facilitate financial transactions between a buyer 110

and a seller 112. (*Id.* ¶ 24.) Order management system 100 preferably communicates

with secure repository via connection 152. (*Id.*) Each firm 100 preferably maintains a

separate connection (*e.g.*, 152A, 152B) with secure repository 104. (*Id.*) Connection 152

may be established via a secure internet or other suitable electronic network connection.

(*Id.* ¶¶ 24-25.) Communication via connection 152 is preferably governed by a field

delimited communication protocol, such as the FIX protocol. (*Id.* ¶ 24.)

Paragraph 0038 of the specification makes crystal clear that in one embodiment,

the "*secure repository matches coded messages as defined by the encoding scheme*

described above." (Specification ¶ 38 (emphasis added).) In another embodiment

"secure repository 104 is not privy to the encoding scheme, and therefore, matches

encoded messages as if they were not encoded." In that embodiment, the meaning of the

messages is known only to the parties to the transaction. (*Id.*)

After notification of a match, traders may confirm the terms of their trades using a

suitable electronic network or telephonic connection.[2] (Specification ¶ 39.) Nowhere

does the specification even remotely suggest that a human must interpret the

---

[2]   The methodology of the embodiments described in Figures 1 and 2 are referred to
as "passive" indications in that secure repository 104 accepts financial messages from
buyers and sellers and matches them based on some criteria. (Specification ¶ 43.) The
embodiments described in connection with Figures 3 and 4 are sometimes referred to as
"active" indications in that the secure repository accepts a message from only one party
(a sender) and actively transmits that message to solicit responses before a match occurs.
(*Id.*) The step 460 of defining how entries in the specified fields of the field delimited
protocol will be interpreted is described in detail in connection with Figure 2. (*Id.* ¶ 50.)

electronically transmitted messages (acting without the aid of a computer or telephone) to have a meaning different than the standard, publicly-known meaning within the field delimited protocol used to communicate those messages.

The Examiner's reliance on *Ex Parte Masham*, 2 U.S.P.Q.2d 1647 (Bd. Pat. App. 1987) (Examiner's Answer at 9) is also misplaced. In *Masham,* the Board of Patent Appeals and Interferences held that a claimed apparatus did not "undergo a metamorphosis to a new device merely by affixing instructions thereto," that it be completely submerged, something that the prior art device also could do. *Id.* at 1648. By contrast, the claims of the present application involve using computing or other communication devices in a manner different than Hausman to do something that the device of Hausman was not programmed to do and was not capable of doing.

In short, the new argument in the Examiner's Answer that claim limitations can be ignored is not based on the actual disclosure of the specification and should be rejected.

III.   Hausman Does Not Disclose, Teach, Or Suggest Interpreting Messages According To A Coded Meaning *Different* Than The Standard, Publicly-Known Meaning Within The Field Delimited Protocol.

Before Examiner Hewitt submitted the Examiner's Answer, Examiner Backer's arguments that Hausman anticipated the pending claims were based principally on paragraph 0075 of Hausman, but also relied on Figures 1, 4, 5 and paragraphs 0005-0012, 0032, 0040, and 0058 of Hausman. We explained in Appellant's Amended Brief on Appeal at pages 13 to 16 why this rejection was incorrect. And the Examiner's Answer

does not argue that these specific portions of Hausman teach, disclose, or suggest interpreting messages in the FIX protocol according to a coded meaning defined to be *different* than the standard, publicly-known meaning in that protocol.

Instead, the Examiner's Answer relies on three other paragraphs of Hausman, on which Examiner Backer did not previously rely. Specifically, the Examiner's Answer argues that "a user can enter a ticker symbol, such as YEN or MSFT into field 311 of figure [4 of Hausman] ([Hausman], paragraph 0034, lines 15-25; paragraph 0035, lines 1-4; paragraph 0065, lines 1-3). Therefore, when a (sell or buy) message is received by a buyer or seller, the buyer or seller is able to decode "YEN" or "MSFT" as a human would (*e.g.*, Japanese currency or the ticker symbol . . .), which is different than the FIX protocol coded message that the buyer or seller computer receives." (Examiner's Answer at 8-9.) This argument misunderstands what the pending claims cover and is factually incorrect.

More specifically, interpreting YEN to mean the Japanese currency and MSFT to be the Microsoft Corporation is not interpreting a message that comprises a financial data field and field corresponding to the financial data field to have a meaning different than a standard, publicly-known meaning within a field delimited protocol.

The specification is replete with examples of interpreting messages to have meanings different than their standard, publicly-known meanings, and we need not repeat them all here. (*See, e.g.*, Amended Brief on Appeal at 4-6, 12-16.) For example, interpreting a message in which a single digit in the quantity field corresponding to a FIX

tag 38 data field (number of shares ordered) to mean a single digit x 10,000 shares is giving that message a different meaning than the standard meaning. Interpreting YEN as the Japanese currency and MSFT as Microsoft Corporation is simply giving those terms their standard meanings.
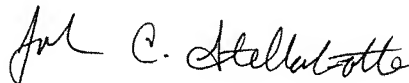
For all these reasons, Hausman does not disclose, teach, or suggest the subject matter of Claims 1, 7, 13, and 22-24. And dependent Claims 2-6, 8-12, and 14-21 are also necessarily patentably distinct from Hausman for at least the same reasons.

IV.   Conclusion

For the reasons set forth herein and in Appellant's Amended Brief on Appeal, it is requested that the final rejection of Claims 1-24, dated May 19, 2006, be reversed. Applicant's undersigned attorney may be reached at (212) 969-3413 or by facsimile at (212) 969-2900. Please continue to direct all correspondence to Customer No. 21890 at the address provided below.

Respectfully submitted,

PROSKAUER ROSE LLP
Attorney for Applicant

By _____

Date: February 27, 2008

John C. Stellabotte
Reg. No. 47,969

PROSKAUER ROSE LLP
Patent Department
1585 Broadway
New York, NY 10036-8299
Telephone: (212) 969-3000